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RESPONSE UNDER 37 C.F.R. §1.116
- EXPEDITED PROCEDURE -
EXAMINING GROUP ART UNIT 2681
BOX AF

Attorney Docket No.: 678-154 (P8378)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Roe-Kwan Kim Examiner: T. Davis
SERIAL NO.: 09/132,351 Group: 2681
FILED: August 12, 1998 Dated: February 21, 2001
FOR: METHOD FOR TRANSMITTING SHORT MESSAGE TO CALLED
SUBSCRIBERS

Assistant Commissioner for Patents
Box AF
Washington, DC 20231

AMENDMENT TRANSMITTAL FORM

Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☐ Small entity status of this application under 37 C.F.R. §§1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity under 37 C.F.R. §§1.9 and 1.27 is enclosed.
- ☒ No additional fee is required.

For	Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate (Small Entity)	Addit. Fee	Rate	Addit. Fee
TOTAL CLAIMS*	14	20	0	x 9 =	\$0	x 18 =	\$0
INDEPENDENT CLAIMS	3	3	0	x 40 =	\$0	x 80 =	\$0
<input type="checkbox"/> First Presentation of Multiple Dep. Claim				135		270	\$0

* If the entry in Col. 1 is less than entry in Col. 2, write "0" in Col. 3.

** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

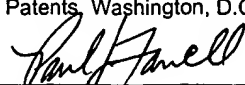
*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The Highest No. Previously Paid For" (Total or indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231 on February 21, 2001.


Dated: February 21, 2001


Paul J. Farrell

- ☐ Please charge Deposit Account No. 04-1121 in the amount of \$____. Two (2) copies of this sheet are enclosed.
- ☐ A check in the amount of \$_____ is enclosed.
- ☒ Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §§1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 04-1121. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 04-1121 therefor. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.

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Respectfully submitted,



Paul J. Farrell
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Attorney for Applicant(s)



#8
TLR
2/27/01
(NE)

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RESPONSE UNDER 37 C.F.R. §1.116

Sir:

Applicant responds to the Office Action of the United States Patent and Trademark Office dated November 21, 2001. Claims 1-14 remain pending in the Application. Claims 11 and 12 were again acknowledged in the Office Action as having allowable subject matter. (Office Action, ¶¶9-11)

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

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Dated: February 21, 2001


Paul J. Farrell

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Claims 1-10, 13 and 14 were rejected in the current Office Action based on the same reasoning presented in the prior Office Action of June 9, 2000. Thus, independent Claims 1 and 9 were rejected under 35 U.S.C. §102(e) as anticipated by the Sanders patent and independent Claim 2 was rejected under 35 U.S.C. §103(a) as obvious over Sanders in combination with Huotari. (Office Action, ¶¶ 3, 5) In addition, dependent Claims 7, 8, 13 and 14 were again rejected under 35 U.S.C. §103(a) as obvious over Sanders in combination with Huotari, dependent Claims 3, 4 and 6 were rejected under 35 U.S.C. §103(a) over Sanders, Huotari and Applicant's purported admission, dependent Claim 5 was rejected under 35 U.S.C. §103(a) over Sanders, Applicant's purported admission and Alanara, and dependent Claim 10 was rejected under 35 U.S.C. §103(a) over Sanders and Applicant's purported admission. (Office Action, ¶¶5-8)

As noted, paragraphs 2-8 of the present Office Action repeat the rejections of Claims 1-10, 13 and 14 of the prior Office Action. Thus, the Examiner will not be burdened with a repetition of the arguments presented in the prior Amendment of September 8, 2000 that distinguish these claims from the cited art, apart from stating that those arguments are all hereby re-asserted. Instead, Applicant will focus on paragraph 12 of the present Office Action, which presents the Examiner's response to the arguments presented in the prior Amendment.

Briefly, it was argued in the prior Amendment that Sanders focuses on directing messages originating from a particular device to a single pre-defined group of

recipients, and that the group of recipients are identified by using the originating device's ID or one of the target addresses that are included in the call request information. Thus, for Claim 1 it was argued that Sanders fails to show (at least) the recitations of "associating each of said plurality of called subscriber numbers with a group identifier, the group identifier being a separately defined field" and "simultaneously transmitting said short message to each of said plurality of called subscriber numbers by designating said group identifier". Analogous distinctions were made regarding Claims 2 and 9.

In response to these arguments presented in the prior Amendment regarding independent Claims 1, 2 and 9, paragraph 12 of the Office Action states that the SMS request information in Sanders "includes an identification of the requesting communication device which is used by the dispatch controller in order to determine the other devices in the talk group" and that, "[t]herefore, the ID of the communication device is what determines the identity of the target group". The Office Action maintains that "this information is a separately defined field because ... the communication device sends its ID in the SMS request and also sends a short message", citing lines 17-41 of col. 10 of Sanders.

Applicant disagrees that the ID of Sander's communication device qualifies as a "group identifier" or a group identifier that is a "separately defined field" as recited in Claims 1, 2 and 9. That the communication device sends its ID in the SMS request simply underscores that it is not a "group identifier" that is a "separately defined field" as

recited in Claims 1, 2 and 9. The Sander's ID is a device identifier, not a separately defined group identifier. Thus, the group identifier as recited in Claims 1, 2 and 9 excludes the ID of the mobile device.

Accordingly, Sanders fails to show (at least) the Claim 1 recitations of "associating each of said plurality of called subscriber numbers with a group identifier, the group identifier being a separately defined field" and "simultaneously transmitting said short message to each of said plurality of called subscriber numbers by designating said group identifier", the Claim 2 recitations of "said short message information including a group identifier and a short message, the group identifier being a separately defined field" and "simultaneously transmitting said short message to subscriber numbers associated with said detected group identifier", and "the Claim 9 recitations of "transmitting from a mobile communication terminal...a group identifier and at least one subscriber number, the group identifier being a separately defined field", "detecting, by a short message service, said group identifier" and "registering said transmitted subscriber numbers in said short message service center in accordance with said detected group identifier". Thus, Sanders fails to anticipate Claims 1 and 9, and fails to render independent Claim 2 obvious. Reconsideration and allowance of independent Claims 1, 2 and 9 is thus respectfully requested. In addition, without conceding the patentability per se of dependent Claims 3-8, 10, 13 and 14, allowance of these dependent claims are respectfully requested by virtue of their dependency on independent Claims 2 and 9.

Applicant again gratefully accepts the acknowledgment in the Office Action that dependent Claims 11 and 12 include allowable subject matter. However, in view of the above remarks and amendments, Applicant maintain that all of the pending claims in this application, namely Claims 1-14, are allowable. Allowance of Claims 1-14 is thus respectfully requested. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,



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Dated: February 21, 2001

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